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EXAMINER

FORD, JOHN K

ART UNIT PAPER NUMBER

3753

DATE MAILED: 02/19/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

The reply filed on Sept 15, 2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): the argument that the Examiner is precluded from inquiring about a mistake of fact by collateral estoppel or res judicata is not really answering the fundamental question of whether or not applicant's Figure 16 in graphically depicting the Marto and Lepere prior art (as a solid line) is a **true and accurate** representation of the prior art Thermoexcel – E surfaces following surface aging C and D. It is that there is only one Marto and Lepere performance curve illustrated in applicant's Figure 16 when Marto and Lepere tested three different enhanced surfaces:

1. Union Carbide High Flux surface,
2. Hitachi Thermoexcel – E surface and
3. Wieland Gewa – T surface,

and each if these surfaces was aged at least three different ways. There are then at least nine different possible surface performances of the Marto and Lepere prior art that Applicant could have tested, yet Applicant's Figure 16 shows that only one surface performance was tested and it cannot be determined from the disclosure which Marto and Lepere surface with which surface aging was tested.

Before the Examiner can indulge counsel's request to either withdraw the rejection or schedule a meeting with the SPE and Group Director, this simple factual question must be answered. Does the Marto and Lepere performance that was illustrated in applicant's disclosure in Figure 16, accurately portray the performance of

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the Thermo excel-E surface following surface aging treatments C and/or D? That the Board relied on applicant's Figure 16 in its decision in regard to reversing the Examiner's rejection based on the Thermoexcel – E surface (with C and D aging) of Marto and Lepere is a conclusion not open to serious debate. What remains an open question however, and one that can only be answered by applicant and/or his test assistants, is what surface and which aging treatment of Marto and Lepere was used to generate the graphical results labeled simply "Marto and Lepere (1982)" in applicant's Fig. 16 that the Board presumed corresponded to the prior art that the Examiner was relying upon.

If the curve shown in applicant's Figure 16 does show the results for the Thermoexcel-E surface with C and/or D aging, then the Examiner intends to withdraw the prior art rejections of claims which explicitly recite the "reversal of trend of less than 2 degrees C and without a temperature overshoot on the initial ascent" limitation. Note however that all of the claims are far broader than the independent claim that the Board considered in its September 29, 2000 decision. It is submitted that none of claims 2, 5, 8 and 10-16 contain this critical limitation that the Board based its decision on. As well, claim 37 contains a limitation that there is no reversal of trend, which arguably doesn't seem to even describe applicant's own disclosed invention. Res judicata and collateral estoppel only apply to claims that are identical or substantially identical to those before the Board in the parent application. The Examiner submits that none of the claims here (with the possible exception of claim 37) are qualified to be passed to issue based

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solely on the doctrines of res judicata and/or collateral estoppel. Even those doctrines, however, to not trump a mistake of fact as this Examiner understands the law. The Examiner would be irresponsible to his office to not inquire if the assumption made by the Board (that Applicant's Figure 16 was an accurate portrayal of the Thermoexcel-E surface with C and/or D aging) in its decision was the correct one. It serves no public purpose to repeat a mistake, if there is one, once it has been identified.

In summary, applicant must be contacted to establish what surface of Marto and Lepere was tested to produce the results plotted in applicant's Figure 16 and what surface aging that surface was given to that surface prior to the test.

Terminal Disclaimer

The Examiner believes counsel is confused about claims 10-33. The Examiner withdrew claims 17-33. Of claims 10-33, only claims 10-16 are active. There is no double patenting rejection of claims 10-33 as alleged on page 7 lines 6-13 of applicant's response.

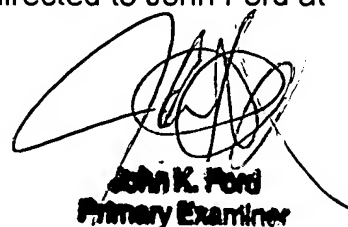
Counsel also argues that a double patenting rejection of claims 1, 2, 5 and 8 is "premature at this time" (page 7, lines 14-17) arguing the rejection should have been a "provisional rejection." Aside from the fact that counsel misstates the claims involved in the rejection (claim 1 has been cancelled and claims 10-16 and 37 have been omitted in

counsel's listing), no reasons are given for applicant's belief that the rejections should have been "provisional". Provisional double patenting rejections, based on the Examiner's knowledge, are only used where the earlier application has not yet matured into a patent. That is not the case here (i.e. USP 6,371,199 has issued).

Since the requirements for terminal disclaimer is proper at this time and applicant has already indicated that he will consider one "at the appropriate time" (Response page 7, lines 18-21), then the terminal disclaimer requirement will not be deferred because it was properly made in the first office action given that USP 6,371,199 has issued. If applicant traverses the double patenting rejection for some new reason, please discuss why the Goodman case (In re Goodman, 11 F. 3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993)) does not control the present situation and requirement for a terminal disclaimer.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Any inquiry concerning this communication should be directed to John Ford at telephone number 703-308-2636.



John K. Ford
Primary Examiner